

Claim Amendments

Applicant agrees to cancel claims 2, 3 “without prejudice or disclaimer”. In addition, claims 23-? have been added to make the canceled claims narrower in scope.

Claim Rejections - 35 U.S.C. § 102

- C. The Examiner rejected claims 1-18 under 35 U.S.C. 103(a) as being unpatentable over Von Bergen and in view of US 5,953,710, herein referred to as Fleming.

In regards to claim 1, applicant respectfully disagrees with the examiner in that although Von Bergen teaches a central location for controlling the gift certificate process and a series of remote locations as noted by the Examiner, the cited reference in combination with Fleming makes no reference of manufacturer information being stored – only retail merchants. Likewise, Fleming talks about the issuer of the credit card (i.e. bank) maintaining transaction information (col. 6, lines 7-19), not the system being described by Von Bergen. **In addition, the combination does not imply in any way the storage of a contribution database for allowing automatic and anonymous charity contributions.** Thus, even the references combined would not meet the claim. Furthermore, the synergism of the whole is greater than the parts, even though some of the parts are used in the other systems. Thus, novel physical distinctions are unobvious under §103.

In regards to claim 2, Applicant agrees to cancel claim 2 “without prejudice or disclaimer”.

In regards to claim 3, the Examiner states that Von Bergen does not specifically mention any restrictions on the use of the gift certificates, but goes on to refer to Fleming, who mentions allowing the parent to restrict the number of purchases made by a child. The Examiner uses the combination, to disallow claim 3, although the references take only a single approach. In the Fleming system, the limitation is only by the number of purchases. **In the proposed system, limitations can also be placed by a) category of product or service; b) age range; c) date range; d) and merchant. Thus, even the**

references combined would not meet the claim. Furthermore, the synergism of the whole is greater than the parts, even though some of the parts are used in the other systems. Thus, novel physical distinctions are unobvious under §103. In addition, the applicant disagrees with the examiner in that in the system discussed by Von Bergren there is no way to place restrictions on the use of the gift certificates because it was intended to be generic enough to work at any online merchant using normal e-commerce purchasing without the requirement of these same merchants interfacing with said system to determine limitations of use. Claim 3 has been reworded to be dependent on claim 1 instead of the removed claim 2. Thus, the applicant requests the examiner to reconsider their decision on this claim.

In regards to claim 4, the Examiner states that Von Bergen does not specifically mention tracking the use of the gift certificate, but goes on to refer to Fleming, who mentions a parents account statement. Although it is true that the Fleming credit card system allows parents to track child transactions, this is at a macro level, and not at the product level as proposed by the applicant's system. Claim 4 has been rewritten to be narrow the claim and be dependent on claim 1 instead of the removed claim 2. Thus, the applicant requests the examiner to reconsider their decision on this claim.

In regards to claim 5, Applicant agrees to cancel claim 5 "without prejudice or disclaimer".

In regards to claims 6, 7, and 8, the Examiner, as stated previously, has made no specific argument against them other than the general claim that Von Bergen shows limitation of these claims. The applicant respectfully disagrees with the examiner in that the only mention of Von Bergen in regards to contributing to a charity is a warning message that the recipient receives prior to the one year expiration date giving them the option to transfer the value of the certificate to the charity rather than have it expire. The applicant's invention allows for charities to be the recipients at the time of purchase as well as on an on-going basis. Thus, the applicant requests the examiner to reconsider their decision on these claims.

In regards to claim 9, the Examiner, as stated previously, has made no specific argument against this claim other than the general claim that Von Bergen shows limitation of these claims. The applicant respectfully disagrees. There is no indication that a single gift certificate can be used on multiple occasions, nor at a plurality of merchants. In fact, the standard practice at the time was for gift certificates to be used for a single transaction. Even if they were allowed across multiple transactions, these transactions were with the same merchant, whereas the applicant's invention provides for splitting the value not only across multiple transactions but across multiple merchants. Thus, the applicant requests the examiner to reconsider their decision on this claim.

In regards to claims 10-16, the Examiner states that Von Bergen does not specifically mention the restrictions of these claims. **Although it is well known in the art to place limitations on credit and debit cards**, the applicant respectfully disagrees **with the examiner of the conclusion that all future limitations are covered since none of these restrictions are currently used in this manner**. In addition, general limits placed on the number of transactions or dollar limit on a credit card are not applicable to limitations placed on electronic gift certificates. Thus the results achieved by this invention are new, unexpected, superior, unusual, and/or surprising. Likewise, up to this time, **those skilled in the art found the problem solved by this invention to be insoluble using standard plastic credit cards**. In fact, except for placing a limit on the amount of transactions, these limitations solve an unrecognizable problem up to this time. Thus the prior-art references do not contain any suggestion (express or implied) that they be combined, or that they be combined in the manner suggested. Even though Fleming mentions a method of restriction, the Examiner has not presented a convincing line of reasoning as to why any type of restriction that is invented later is invalid. Thus, even the references combined would not meet the claim. **Even to this day, no other systems place the kind of restrictions on gift certificate used as stated in claims 11, 12, 13, 14, 15, and 16**. In addition, claim 11 allows for a fixed shipping address to be associated with any purchases made with a electronic gift certificate. This would restrict the shipments of any online purchases to a specified address. This would be useful if the gift certificate was given to a child or elderly parent in which the purchaser wants to make sure that the items

purchased are not against the purchaser's wishes. Note, there are no systems in place today that do this and it is not obvious from the prior art. Furthermore, the synergism of the whole is greater than the parts, even though some of the parts are used in the other systems. Thus, novel physical distinctions are unobvious under §103 and the applicant requests the examiner to reconsider these claims.

In regards to claims 17 and 18, the office action incorrectly included these with claims 11, 12, 13, 14, 15, and 16. Claims 17 and 18 were also rejected by the examiner as being unpatentable over Von Bergen. The applicant respectfully disagrees with the examiner as stated above in claims 6, 7, and 8 due to Von Bergen' only mention of charities is a warning message that the recipient receives prior to the one year expiration date giving them the option to transfer the value of the certificate to the charity rather than have it expire. The applicant's invention allows for charities to be the recipients at the time of purchase as well as on an on-going basis. Thus, the applicant requests the examiner to reconsider their decision on these claims.

In regards to claims 19-22, Applicant agrees to cancel these claims "without prejudice or disclaimer".

Prior Art

The prior art that was specified in the original patent application submission is no longer included in the 'Other Prior Art' section of Form PTO-1449. Specifically the references that should be included are:

1. Vesely, Rebecca, Kiddie Kash, Business 2.0, May 1999, page 24-26.
2. Dalton, Gregory, Clipless Coupons, Information Week, February 22, 1999, page 87.
3. Mollman, Steve, Smells Like Teen Commerce, Wired, June 1999, page 194.

Fees

Applicant has filed this response prior to the expiration of three months and have not presented additional claims. Accordingly, Applicant believes that no additional fees are due for consideration of this response.